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Mark P. Lowell

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EXAMINER

CARLOS, ALVIN LEABRES

ART UNIT

PAPER NUMBER

3715

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/698,862	Applicant(s) LOWELL ET AL.	
	Examiner ALVIN L. CARLOS	Art Unit 3715	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-52 and 55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-52 and 55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a Final Office action in response to communications received April 27, 2010. Claims 27-52 and 55 are now pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 27-52 and 55 stand rejected under 35 USC 101 as being directed to non-statutory subject matter because these are method or process claims that do not transform underlying subject matter (such as an article or materials) to a different state or thing, nor are they tied to a particular machine. See Diamond v. Diehr, 450 U.S. 175, 184 (1981) (quoting Benson, 409 U.S. at 70); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978) (citing Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)). See also In re Bilski (Fed Cir, 2007-1130, 10/30/2008) where the Fed. Cir. held that method claims must pass the "machine-or-transformation test" in order to be eligible for patent protection under 35 USC 101. In order for a claimed process to be considered statutory it must be direct to more than an abstract idea. Evidence that the process is more than an abstract idea can be found if the process is: (1) tied to a particular machine or apparatus, or (2) transform a particular article into a different state or thing. The use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility; the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution

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activity; and the transformation must be central to the purpose of the claimed process.

In this instant case, claims 27-52 and 55 fails to tie a particular machine or device to implement the method as claimed nor transform a particular article into a different state or thing.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 27-52 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horan 6220596 in view of Weingardt 5727786 and further in view of Weeks 3549150.

Re claim 27, Horan discloses a method of playing a game of bingo (column 1 lines 10-11) comprising designating a set of potential numbers for the game (column 5 lines 35-42), designating a plurality of subsets of the potential numbers for the game (column 7 lines 12-33), associating each of the plurality of subsets with bingo card column (column 2 lines 43-56), providing bingo card to player including a plurality of spaces being arranged in a matrix of rows and columns (see figure 2-3 and the related description thereof), wherein each of the spaces contains either a number from the subset of numbers associated with the column in which the space appears or a free space indicator (column 2 lines 43-57), designating first pattern of spaces on a bingo

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card as determinative of a winner of the game, wherein the pattern including column of spaces on the bingo card (column 5 lines 26-42), repeating the process of selecting numbers at random from the set of potential numbers for the game until the game ends (column 5 lines 39-42), paying the player a win value if the player has a bingo card with numbers matching those selected from the set of potential numbers, and if the pattern formed by the matching numbers matches the first pattern designated as a winning pattern (column 6 line 23 - column 8 line 18), and In addition to the win value, paying a first bonus to the player if the player has a bingo card with numbers matching those selected from the set of potential numbers and if the pattern formed by the matching numbers matches the first pattern designated as a winning pattern, (column 6 line 23 - column 8 line 18).

Horan discloses all of the claimed subject matter as discussed above with the exception of disclosing the feature of providing a first set of colors, associating each of the first set of colors with a win enhancement value, associating the first set of colors to at column without regard to the associated subset of potential numbers for the column, the value of the first bonus equals the win enhancement value associated with the color associated with the column in which the win occurs.

However, Weingardt teaches providing a first set of colors (column 4 lines 61-65), associating each of the first set of colors with a win enhancement value (column 5 lines 43-45), the value of the first bonus equals the win enhancement value associated with the color in which the win occurs (column 7 lines 4-27).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Horan's invention in view of Weingardt in order to provide an additional features added to the bingo game that will allow more payouts to be made by the gaming establishment that result in increased player participation and additional revenues to the gaming establishment as taught by Weingardt (column 3 lines 25-30).

Horan in view of Weingardt discloses all of the claimed subject matter as discussed above with the exception of disclosing the feature of associating the first set of colors to column without regard to the associated subset of potential numbers for the column.

However, Weeks teaches associating the first set of colors to column without regard to the associated subset of potential numbers for the column (see figure 1, column 1 lines 47-61).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Horan in view of Weingardt invention by incorporating Weeks teaching of assigning each column with distinctive color differing from the colors employed in the remaining columns in order to provide a comprehensive combination of color, spaces, patterns and numbers added to the bingo game that will allow more payouts to be made by the gaming establishment that result in increased and encourage player participation.

Re claim 28, Horan in view of Weingardt in view of Weeks discloses all of the claimed subject matter as discussed above. In addition, Weingardt discloses selecting at least one number at random from each of the subsets to serve as a win enhancement

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activator and paying the at least one player the first bonus only if the pattern formed by the matching numbers contains at least one win enhancement activator (column 4 line 50 – column 6 line 3).

Re claim 29, Horan in view of Weingardt in view of Weeks discloses all of the claimed subject matter as discussed above. In addition, Weingardt discloses designating at least one second pattern of spaces on a bingo card as determinative of a winner of the game including at least a row of spaces on the bingo card (column 4 lines 65-67 and column 5 line 1), providing a set of graphics (column 5 lines 15-25), associating each of the set of graphics with a win enhancement value (column 5 lines 43-55), associating at least one of the set of graphics to rows on the bingo card (column 1 lines 31-40 and column 7 lines 15-24), and paying a second bonus to the at least one player if the at least one player has a bingo card with numbers matching those selected from the set of potential numbers, and if the pattern formed by the matching numbers matches the at least one second pattern designated as a winning pattern, wherein the second bonus equals the win enhancement value associated with the graphic associated with the row in which the win occurs (column 7 lines 29-65).

Re claim 30, Horan in view of Weingardt in view of Weeks discloses all of the claimed subject matter as discussed above. In addition, Weingardt discloses selecting one number at random from each of the subsets to serve as a win enhancement activator (column 6 lines 42-62), and paying the at least one player the second bonus only if the pattern formed by the matching numbers contains at least one win enhancement activator (column 8 lines 9-20).

Re claim 31, Horan in view of Weingardt in view of Weeks discloses all of the claimed subject matter as discussed above. In addition, Weingardt discloses selecting at least one number at random from each of the subsets to serve as a win enhancement activator (column 6 lines 42-62), paying the player the first bonus only if the pattern formed by the matching numbers contains at least one win enhancement activator (column 7 lines 44-65) and paying the player the second bonus only if the pattern formed by the matching numbers contains at least one win enhancement activator (column 8 lines 9-20).

Re claims 32-37, Horan in view of Weingardt in view of Weeks discloses all of the claimed subject matter as discussed above. In addition, Horan discloses a bingo card method wherein the pattern of spaces includes a pattern of contiguous spaces, vertical column of spaces, horizontal row of numbered spaces, diagonal pattern, or noncontiguous spaces on the bingo card (See figure 2-3 and the related description thereof, column 5 lines 26-42).

Re claims 38-39, Horan in view of Weingardt in view of Weeks discloses all of the claimed subject matter as discussed above. In addition, Horan discloses the random numbers are generated by selecting a ball having a number printed on it from a plurality of balls and the bingo card is maintained and displayed electronically by a card tending device (column 3 lines 22-51 and column 5 lines 35-42).

Re claims 40-41, Horan in view of Weingardt in view of Weeks discloses all of the claimed subject matter as discussed above. In addition, Horan discloses the number associated with the randomly selected ball is manually entered into the card tending

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device by the player and the bingo card is marked by the player interacting with the card tending device (column 4 lines 10-67 and column 6 line 59 – column 7 line 11).

Re claims 42-43, Horan in view of Weingardt in view of Weeks discloses all of the claimed subject matter as discussed above. In addition, Horan discloses the bingo card is maintained and displayed electronically by a card-tending device and the random numbers are generated by a computing device and communicated to the card-tending device (column 3 line 22 – column 4 line 65).

Re claim 44, Horan in view of Weingardt in view of Weeks discloses all of the claimed subject matter as discussed above. In addition, Horan discloses the win enhancement value is a progressive prize (column 7 lines 1-11).

Re claims 45 and 46, Horan in view of Weingardt in view of Weeks discloses all of the claimed subject matter as discussed above. In addition, Horan discloses the progressive prize is incremented at an accelerated rate and incremented to reflect live updating of the prize amount (column 3 lines 1-21 and column 6 lines 6-58).

Re claims 47-52, Horan in view of Weingardt in view of Weeks discloses all of the claimed subject matter as discussed above. In addition, Horan in view of Weingardt in view of Weeks discloses a method wherein the columns or rows to which the at least one first indicator is assigned contains a unique indicator ((see Horan, "Free Space" of Fig. 2-3 and the related description thereof, column 2 lines 43-65 and column 3 lines 23-47) and (see Weingardt, red , "blue , "green , "yellow" indicators, column 3 lines 10-20 and column 5 lines 9-64)).

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Re claim 55, Horan discloses a method of playing a game of bingo (column 1 lines 10-11) comprising designating a set of potential numbers for the game (column 5 lines 35-42), designating a plurality of subsets of the potential numbers for the game (column 7 lines 12-33), associating each of the plurality of subsets with bingo card column (column 2 lines 43-56), providing bingo card to player including a plurality of spaces being arranged in a matrix of rows and columns (see figure 2-3 and the related description thereof), wherein each of the spaces contains either a number from the subset of numbers associated with the column in which the space appears or a free space indicator (column 2 lines 43-57), designating first pattern of spaces on a bingo card as determinative of a winner of the game, wherein the pattern including column of spaces on the bingo card (column 5 lines 26-42), repeating the process of selecting numbers at random from the set of potential numbers for the game until the game ends (column 5 lines 39-42), paying the player a win value if the player has a bingo card with numbers matching those selected from the set of potential numbers, and if the pattern formed by the matching numbers matches the first pattern designated as a winning pattern (column 6 line 23 - column 8 line 18), and In addition to the win value, paying a first bonus to the player if the player has a bingo card with numbers matching those selected from the set of potential numbers and if the pattern formed by the matching numbers matches the first pattern designated as a winning pattern (column 6 line 23 - column 8 line 18), and paying, in addition to the win value, a second bonus to the at least one player if the at least one player has a bingo card with numbers matching those selected from the set of potential numbers, if the pattern formed by the matching

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numbers matches the second pattern designated as a winning pattern (column 7 lines 29-65), and if the pattern formed by the matching numbers contains at least one win enhancement activator wherein the value of the second bonus equals the win enhancement value associated with the graphic associated with the row in which the win occurs (column 8 lines 9-20).

Horan discloses all of the claimed subject matter as discussed above with the exception of disclosing the feature of providing a first set of colors, associating each of the first set of colors with a win enhancement value, associating the first set of colors to at column without regard to the associated subset of potential numbers for the column, the value of the first bonus equals the win enhancement value associated with the color associated with the column in which the win occurs, designating at least one second pattern of spaces on a bingo card as determinative of a winner of the game including at least a row of spaces on the bingo card, providing a set of graphics, associating each of the set of graphics with a win enhancement value, associating at least one of the set of graphics to rows on the bingo card, and selecting at least one number at random from each of the subsets to serve as a win enhancement activator.

However, Weingardt teaches providing a first set of colors (column 4 lines 61-65), associating each of the first set of colors with a win enhancement value (column 5 lines 43-45), the value of the first bonus equals the win enhancement value associated with the color associated with the column in which the win occurs (column 7 lines 4-27), designating at least one second pattern of spaces on a bingo card as determinative of a winner of the game including at least a row of spaces on the bingo card (column 4 lines

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65-67 and column 5 line 1), providing a set of graphics (column 5 lines 15-25), associating each of the set of graphics with a win enhancement value (column 5 lines 43-55), associating at least one of the set of graphics to rows on the bingo card (column 1 lines 31-40 and column 7 lines 15-24), and selecting at least one number at random from each of the subsets to serve as a win enhancement activator (column 7 lines 4-27).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Horan's invention in view of Weingardt in order to provide an additional features added to the bingo game that will allow more payouts to be made by the gaming establishment that result in increased player participation and additional revenues to the gaming establishment as taught by Weingardt (column 3 lines 25-30).

Horan in view of Weingardt discloses all of the claimed subject matter as discussed above with the exception of disclosing the feature of associating the first set of colors to at column without regard to the associated subset of potential numbers for the column.

However, Weeks teaches associating the first set of colors to at column without regard to the associated subset of potential numbers for the column (see figure 1, column 1 lines 47-61).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Horan in view of Weingardt invention by incorporating Weeks teaching of assigning each column with distinctive color differing from the colors employed in the remaining columns in order to provide a comprehensive combination of

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color, spaces, patterns and numbers added to the bingo game that will allow more payouts to be made by the gaming establishment that result in increased and encourage player participation.

Response to Arguments

6. Applicant's arguments filed 04/27/2010 have been fully considered but they are not persuasive.

7. With regards to the applicant's traversing the 101 rejection without providing any reasoning why the applicant traverse the 101 rejection, the Examiner reject claims 27-52 and 55 under 35 USC 101 as being directed to non-statutory subject matter because these are method or process claims that do not transform underlying subject matter to a different state or thing, nor are they tied to a particular machine.

8. In response to applicant's argument that there is no teaching, suggestion, or motivation to combine the references, the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). In this case, Horan discloses bingo game system that provide payout based on the winning combination of numbers and pattern of elements that matches any one of the primary

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predesignated winning sets of elements and the first player wins when one of said random sets of elements matches any one of the primary predesignated winning sets of elements. In addition, Weingardt discloses a bingo game that associate colors with group of numbers in determining the preestablished payout, wherein grouping would include associating numbers with colors to patterns and position/location or any combination thereof on the bingo card in order to determine the preestablished payout value. Weingardt teaches providing payout based on the set of colors with a win enhancement value, and the value of the first bonus equals the win enhancement value associated with the color (column 5 lines 43-45 and column 7 lines 4-27). Therefore, it would have been obvious to one of ordinary skill in the art to modify Horan in view of Weingardt winning criteria in determining the payout by incorporating Weeks teaching of associating column/row with distinctive color as an additional predetermine winning criteria in determining payout value in order to provide a bingo game that would allow more jackpot opportunities and payouts combination criteria that would result in increased and encourage player participation.

9. In response to the applicant arguments that Horan in view of Weingardt in view of Weeks does not disclose "selecting at least one number at random from each of the subsets to serve as a win enhancement activator, and paying [...] the first bonus only if the pattern formed by the matching numbers contains at least one win enhancement activator", the Examiner disagrees. Weingardt describes that colors are associated with group of numbers, and that different number with associated colors have different payout values. In addition, Weingardt discloses "selecting at least one number at

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random from each of the subsets" to serve as a win enhancement activator and paying bonus only if the pattern formed by the matching numbers contains at least one win enhancement activator" (number associated with particular color) (column 4 line 50 - column 6 line 3). Furthermore, Weingardt discloses a bingo game that determines the payout value by associating colors with a group of numbers as a winning activator. It would have been obvious to one of ordinary skill in the art to modify Horan in view of Weingardt criteria for determining the payout value by incorporating Weeks teaching of associating different colors to different row or column in order to provide additional winning criteria to the bingo game that would allow more jackpot opportunities and payouts.

10. In response to applicant's arguments that the prior art does not show or suggest "associating set of colors to column without regard to the associated subset of potential numbers", the Examiner disagrees. Since Horan in view of Weingardt discloses the payout based on associating colors with a group of numbers and patterns on the bingo card, it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute Weeks teaching of associating colors with columns or rows as a winning activator in providing bonuses in order to provide a more fun and exciting variation of bingo game that would generate a more player participation and more player enthusiasm.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALVIN L. CARLOS whose telephone number is (571)270-3077. The examiner can normally be reached on 7:30am-5:00pm EST Mon-Fri (alternate Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571)272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kathleen Mosser/
Primary Examiner, Art Unit 3715

/A.C./
Examiner, Art Unit 3715
July 17, 2010